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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,148	07/09/2003	Gennosuke Mutoh	2271/69807	9758
7590 Ivan S. Kavrukov, Esq. Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER BRIER, JEFFERY A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/616,148		MUTOH, GENNOSUKE	
	Examiner		Art Unit	
	Jeffery A. Brier		2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19, 21-38 and 40-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-19, 21-38, and 40-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2007 has been entered.

Response to Amendment

2. The amendment filed on 5/29/2007 has been entered. The amendments to the claims overcome the 35 USC 101 rejection set forth in the office action mailed on 2/23/2007, however, the amendments raise 35 USC 112 first and second paragraph issues set forth below.

Response to Arguments

3. Applicant's arguments filed 5/29/2007 concerning Nakami have been fully considered but in view of 35 USC 112 first and second paragraph issues introduced by the 5/29/2007 claim amendments a comparison of Nakami and the claimed invention is difficult.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-19, 21-38, and 40-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 4 and 23 were amended to claim “a copying machine and a printer”, however, the specification only discusses “copying machine” in the Description of the Related Art, thus, the specification fails to convey applicant had possession of a copying machine that has the claimed parts or performed the claimed steps. Their dependent claims do not correct this issue.

Independent claims 4 and 23 were amended to claim “a copying machine and a printer” and implies the claimed “a copying machine and a printer” has the claimed parts of apparatus claim 4 or performs the steps of method claim 23, however, the specification only describes a printer that uses a table, see figures 8-11 and corresponding specification at pages 20-29 and see page 42 lines 1-11 and page 50 lines 1-18, and does not describe a copying machine or printer calculating the sharing ratio Z_m . Thus, the specification fails to convey applicant had possession of a “copying

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machine” or a “printer” that has the claimed parts in apparatus claim 4 or performs the steps of method claim 23. Their dependent claims do not correct this issue.

The specification fails to convey applicant had possession of an apparatus as claimed in claim 4 as well as its dependent claims that is both “a copying machine and a printer” and fails to convey applicant had possession of a method as claimed in claim 23 as well as its dependent claims that functions as both “a copying machine and a printer” because the specification only discusses a copying machine and a printer in the alternative in the Description of the Related Art and only discusses a printer in the Description of the Preferred Embodiments.

The specification does not convey sharing-ratio part of apparatus claim 4 is in “copying machine” or “printer” while other parts are in image processing apparatus due to claim language at line 16 and does not convey sharing-ratio step of method claim 23 is performed in “copying machine” or “printer” while other steps are performed in image processing method due to claim language at lines 15 and 16 because the specification with regard to figures 8-11 and corresponding specification at pages 20-29 does not discuss performing the claimed calculation in a “copying machine” or “printer” while other claimed parts or steps are elsewhere.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-19, 21-38, and 40-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 4 and 23:

Apparatus claim 4 and method claim 23 suffer from the following same indefinite issues:

The specification describes a table is preferred to a calculation and the calculation is used to create the table, see page 42 lines 1-11 and page 50 lines 1-18. In apparatus claim 4 from lines 10-21 and in method claim 23 from lines 9-21 the claims do not clearly claim if the claimed invention is using the calculated table for changing the size of image data of an original image, is only the creation of the table for use in changing the size of the image, or is only the calculation of the sharing ratio Z_m for use in changing the size of the image. These independent claims as well as their dependent claims do not clearly claim to use the sharing ratio to change the size of the original image in view of the "for changing the size of the image" at line 7 of both claims 4 and 23. In essence they only claim to calculate the sharing ratio.

In apparatus claim 4 at line 16 and in method claim 23 at lines 15-16 applicant is claiming a copying machine and a printer, however, these claims as well as their dependent claims are unclear if the remaining claimed parts or steps are being performed in "at least one of a copying machine and a printer".

In apparatus claim 4 and in method claim 23 the body of the claim does not clearly claim how the function of the preamble is performed since the body of the claim does not claim how to change the size of the original image. The body of the claim only claims how to obtain the sharing ratio due to the vague language "for changing the size

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of the image data between a first processing way and a second processing way” at line 7 of both claims 4 and 23.

Apparatus claim 4 at line 16 and method claim 23 at lines 15-16 do not clearly claim in the phrase “at least one of a copying machine and a printer” a copying machine or a printer which is important since the specification does not describe the apparatus and method as a copying machine and a printer. The following court cases discuss how the courts would interpret the phrase “at least one of a copying machine and a printer”.

Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 69 USPQ2d 1865, 1878 (Fed. Cir. 2004).

Page 1878 states:

We agree with DirecTV. The phrase “at least one of” precedes a series of categories of criteria, and the patentee used the term “and” to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that “an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term.” Willaim Strunk, Jr. & E. B. White, *The Elements of Style* 27 (4th ed. 2000). Thus, “[i]n spring, summer, or winter” means “in spring, in summer, or in winter.” *Id.* Applying this grammatical principle here, the phrase “at least one of” modifies each member of the list, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category; that is, at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type.

IPXL Holdings LLC v. Amazon.com Inc., 72 USPQ2d 1469 (DC EVa 2004) makes a decision similar to SuperGuide. Page 1480 states:

The parties dispute whether “user defined transaction information” requires both a “user defined transaction” *and* a “user defined transaction parameter” as Amazon contends, or only one of either a “user defined transaction” *or* a “user defined transaction parameter,” as IPXL contends. For the reasons set forth below, the Court finds that IPXL misreads both the plain words used in the claim as well as Federal Circuit precedent in arguing for its interpretation. In construing the very same language, the Federal Circuit construed “at least one of” to mean what Amazon has argued.

The phrase “at least one of” precedes a series of categories of criteria, and the patentee used the term “and” to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that “an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term.”

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William Strunk, Jr. & E.B. White, *The Elements of Style* 27 (4th ed. 2000)... . Applying this grammatical principle here, the phrase “at least one of” modifies each member of the list, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category... .*SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 886 [69 USPQ2d 1865] (Fed. Cir. 2004).

CAFC decision *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375 (Fed. Cir. 2001)
This decision found that the term “or” in claim 16 in the *at least one of two-digit, three-digit, or four-digit year-date representations* phrase is to be read in the alternative when read in light of the specification. Page 1378 states:

The district court construed the word “or” in claim 16 as meaning that the apparatus was capable of converting “only two-digit, only three-digit, only four-digit, or any combination of two-, three-, and four-digit date-data.” Slip op. at 9. We agree with this construction of the claim, for it is the plain reading of the claim text. These are not technical terms of art, and do not require elaborate interpretation. There is no basis in the specification or prosecution history for reading “or” as “and” — nor does Dr. Brown request such a reading.

Claim 4:

In apparatus claim 4 at line 16 “the image forming apparatus” lacks antecedent basis in the claim.

Claims 2 and 21:

These claims modifies the first processing way of their parent claim by using the word “comprises” and this does not clearly claim whether the “high-order image processing” is changing of the size of the image or is a different type of “high-order image processing” when the first processing way comprises “high-order image processing”.

Claims 10, 29, 14, and 33:

These claims claim determining the sharing ratio according to factors other than time needed to perform the calculation claimed in the parent claims, thus, it is not clear if these claims are replacing time found in the parent claims with “predetermined attribute of the original image” or “contents of image processing” or adding to time found in their parent claims. Even in light of the specification the metes and bounds of these claim are indefinite.

Claims 11 and 30:

These claims claim “permissible time duration” while parent claims 4 and 23 claim “given time duration”, however, in light of the specification it appears “permissible” and “given” time duration may be the same, however, the claims do not clearly claim whether they are the same time duration. Correction or explanation is requested.

The dependent claims do not correct the issues of their parent claims.

8. A proper prior art analysis of the claims cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-

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7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628